

REMARKS

The above amendments and these remarks are responsive to the Office Action issued on December 27, 2004. Claims 1-4, 6 and 7 are now active for examination.

The Office Action dated December 27, 2004 rejected claims 1, 2 and 7 under 35 U.S.C. §102(b) as being anticipated by Fisher (U.S. Patent No. 4,911,594). Claim 4 stood rejected under 35 U.S.C. §103(a) as being unpatentable over Fisher in view of Frederick (U.S. Patent No. 3,203,302). Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Fisher. The Office Action ruled that claim 3 would be allowable if the claim is rewritten into independent form including every limitation of its base claim. The Examiner objected to the drawings for formality reasons.

Applicant respectfully submits that the rejections are overcome and the objection is addressed, in view of the amendment and remarks presented herein. Reconsideration of the claims and withdrawal of the rejections are respectfully requested.

The Anticipation Rejection of Claims 1, 2 and 7 Is Traversed.

Claims 1-5 and 7 were rejected under 35 U.S.C. § 102(b) as being anticipated by Fisher. The anticipation rejection is respectfully traversed because Fisher cannot support a prima facie case of anticipation.

Independent claim 1 describes an attachment clip for attaching a first member to a second member having a bolt projecting therefrom. This first member has a bolt hole formed to allow passage of a shank of the bolt. The attachment clip comprises a clip body and a plurality of engagement claws. The clip body has an abutting part for abutment on the first member. The

abutting part has a shank hole for passage of the shank of the bolt. The plurality of engagement claws are formed around the shank hole so as to project in the inner periphery of the clip body to the shank hole inwardly in a radial direction. The claws are also inclined to the clip body so that respective engagement tips of the engagement depart from the clip body along an axial direction of the attachment clip. This provides the engagement claws as a whole with a substantial cone-shaped configuration. The engagement claws can engage with the shank of the bolt of the second member while urging the first member toward the second member along an axial direction of the bolt. The engagement claws include at least two specific claws adjoining in the circumferential direction of the shank hole. The engagement tips of the two specific claws are apart from each other at a predetermined distance in a direction of the height of the attachment clip. This predetermined distance is equal to one or more pitches of threads formed on the shank of the bolt.

On the other hand, Fisher describes a push-nut type fastener having a plurality of resilient spring finger members 16, and spring fingers 18. In fact, the fastener described in Fisher is the type of problematic conventional fasteners (as shown in Fig. 13 of the written description) that the present invention seeks to resolve.

The Office Action asserted that spring finger member 16 and spring fingers 18 of Fisher's fastener correspond to the two specific claws as described in claim 1. However, even though there is a height difference between spring finger member 16 and spring fingers 18, Fisher fails to specifically teach that the height difference is equal to one or more pitches of threads formed on the shank of the bolt, as required by claim 1. Since Fisher fails to teach every limitation of claim 1, Fisher cannot support a prima facie case of anticipation. The anticipation rejection is untenable and should be withdrawn. Favorable reconsideration of claim 1 is respectfully requested.

Claim 2 depends on claim 1 and incorporates every limitation thereof. Accordingly, based on at least the same reasons as for claim 1, claim 2 is patentable over Fisher. Favorable reconsideration of claim 2 is respectfully requested.

Similar to claim 1, independent claim 7 also requires that “the engagement tips of the two specific claws are apart from each other at a predetermined distance,...wherein the predetermined distance is **equal to** one or more pitches of threads from on the shank of the bolt.” (Emphases added) As discussed earlier relative to claim 1, Fisher fails to disclose these features. Consequently, Fisher cannot support a prima facie case of anticipation. Hence, claim 7 is patentable over Fisher. Favorable reconsideration of claim 7 is respectfully requested.

The Obviousness Rejection of Claim 6 Is Overcome

Claim 6 depends on claim 1 and was rejected as being unpatentable over Fisher. As discussed earlier, claim 1 is patentable over Fisher. Accordingly, claim 6 is also patentable over Fisher by virtue of its dependency from claim 1, as well as based on its own merits. Favorable reconsideration of claim 6 is respectfully requested.

The Obviousness Rejection of Claim 6 Is Overcome

Claim 4 depends on claim 1 and incorporates every limitation thereof. The Office Action rejected claim 4 as being unpatentable over Fisher in view of Fredrick. The obviousness rejection is respectfully traversed because Fisher and Fredrick cannot support a prima facie case of obviousness.

As discussed earlier relative to claim 1, Fisher fails to disclose that “the engagement tips of the two specific claws are apart from each other at a predetermined distance,...wherein the predetermined distance is **equal to** one or more pitches of threads from on the shank of the bolt,” as

required by claim 4 by virtue of its dependency of claim 1. Frederick does not alleviate this deficiency. Therefore, Fisher and Fredrick, even combined, do not include every limitation of claim 4, and cannot support a *prima facie* case of obviousness. Hence, the obviousness rejection is untenable and should be withdrawn. Favorable reconsideration of claim 4 is respectfully requested.

Claim 3 Is Patentable

Claim 3 was objected to for depending from a rejected base claim, but the Examiner indicated that claim 3 would be allowable if it is rewritten into independent form including every limitation of its base claim.

As discussed earlier, claim 1, the base claim from which claim 3 depends, is patentable over the publications of record. Consequently, claim 3 is patentable for at least the same reasons as for claim 1, as well as based on its own merits. Favorable reconsideration of claim 3 is respectfully requested.

The Objection to the Drawings Is Addressed

Figs. 1-4 were objected to for failing to include the legend “Prior Art.” By this Response, new Figs. 1-4 with the legend “Prior Art” are submitted. Applicant submits that the drawings are now in proper form.

CONCLUSION

In light of the amendments and remarks above, this application should be considered in condition for allowance and the case passed to issue. If there are any questions regarding this

Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Wei-Chen Nicholas Chen
Recognized under 37 CFR §10.9(b)

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 WC:apr
Facsimile: 202.756.8087
Date: March 28, 2005

**Please recognize our Customer No. 20277
as our correspondence address.**

AMENDMENT TO THE DRAWINGS

Please replace Figs. 1-4 with the attached replacement drawings. Per the Examiner's request, the amended drawings added the legend "Prior Art" in Figs. 1-4. No new matter is introduced.